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OFFICE OF PETITIONS

In re Application of
John W. Holaday et al
Application No. 10/799,163
Filed: March 12, 2004
Attorney Docket No. 05213-0077
(13663.105206)

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DECISION ON PETITION
UNDER 37 CFR 1.78(a)(3)

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This is a decision on the petition under 37 CFR 1.78(a)(3), filed December 18, 2006 and resubmitted on January 16, 2007, which is being treated as a petition to accept an unintentionally delayed claim under 35 U.S.C. §§ 120 and 365(c) for the benefit of priority to prior-filed international Application No. PCT/US00/06320, filed September 14, 2000, and as a petition to accept an unintentionally delayed claim under 35 U.S.C. § 119(e) for the benefit of priority to prior filed provisional Application No. 60/077,460, filed March 10, 1998, as set forth in the accompanying amendment.

The petition is **DISMISSED**.

A petition for acceptance of a claim for late priority under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii). In addition, the petition under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) must be accompanied by:

- (1) the reference required by 35 U.S.C. §§ 120 and 119(e) and 37 CFR §§ 1.78(a)(2)(i) and (iii) and 1.78(a)(5)(i) and (iii) of the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Director may require additional where there is a question whether the delay was unintentional.

The petition fails to currently satisfy item (1) above. In this regard, the amendment to claim benefit of priority to international Application No. PCT/US00/06320 improperly sets forth the filing date of the application. More specifically, the amendment indicates that the filing date of the PCT application is September 14, 2000, whereas, the correct filing date is March 10, 2000.

Accordingly, an amendment which properly sets forth the filing date of the PCT application, along with a renewed petition under 37 CFR 1.78(a)(3), is required.

It is further noted in a review of the computer database records that Application No. 09/265,213 fails to disclose the presence of a proper chain for benefit of priority to the prior-filed applications noted in the amendment. More specifically, Office database records do not reflect that Application No. 09/265,213 has claimed benefit of priority to Application No. 08/467,101 and the other applications in the chain; namely, Application Nos. 08/271,557 and 08/068,717.

Where an application claims a benefit under 35 U.S.C. 120 of a chain of applications, the application must make a reference to the first (earliest) application and every intermediate application. *See Sampson v. Ampex Corp.*, 463 F.2d 1042, 1044-45, 174 USPQ 417, 418-19 (2d Cir. 1972); *Sticker Indus. Supply Corp. v. Blaw-Knox Co.*, 405 F.2d 90, 93, 160 USPQ 177, 179 (7th Cir. 1968); *Hovlid v. Asari*, 305 F.2d 747, 751, 134 USPQ 162, 165 (9th Cir. 1962). See also MPEP § 201.11. In addition, every intermediate application must also make a reference to the first (earliest) application and every application after the first application and before such intermediate application. MPEP Section 201.06(d).

Further correspondence with respect to this matter should be addressed as follows:

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Any questions concerning this matter may be directed to the undersigned at (571) 272-3218.

Frances Hicks
Petitions Examiner
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